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In re Application of)
Rene-Paul BLANC et al.)
Application No. 09/533,825)
Filed: March 24, 2000)
For: DISPOSABLE ELECTRONIC CHIP)
DEVICE AND PROCESS OF)
MANUFACTURE)

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.144, filed July 27, 2001, requesting withdrawal of the finality of the restriction requirement and examination of all the claims pending in the above-identified application.

The restriction requirement was made final in the Office action mailed July 5, 2001. Claims 1-30 were examined and claims 31-47 were withdrawn from consideration by the examiner as being drawn to a non-elected invention.

Petitioner asserts that the restriction between the inventions of claims 1-30 and of claims 31-47 is improper pursuant to M.P.E.P. § 803 and M.P.E.P. § 806.5(f) because "There are two criteria for a proper restriction. The first of these is that a showing must be made that the inventions are independent or distinct as claimed. In the Office Action, the groups were characterized as being directed to a product and process for making the product ... under these circumstances distinctness can be shown if the product as claimed can be made by another and materially different process. In support of the restriction, the Office Action states that the electronic chip device of claims 1-30 can be made by a screening process." Petition further asserts "there is no showing in either of the Office Actions that a screening process is materially different from the process recited in a number of the claims of the second group."

A restriction requirement was mailed on April 10, 2001 holding that the claims in the application are directed to two distinct inventions which are related as product and process of making the product: the product being an electronic chip device set forth in claims 1-30, and the process of making the electronic chip device being set forth in claims 31-47. To support the determination

that the two inventions are patentably distinct, the product is shown to be made by materially different process such as the chip can be made by a screening process.

Regulations and Practice

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction there between should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

M.P.E.P. § 806.05(f) deals with restrictions between inventions directed to a process of making and product made and states, in part, as follows:

A process of making and product made can be shown to be distinct inventions if either or both of the following can be shown: (1) the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

37 CFR § 1.144 states as follows:

After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.)

If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.2.

Opinion

A restriction requirement, once made final, may be petitioned pursuant to 37 CFR § 1.144. For

restriction requirements dealing with a process of making and product made, M.P.E.P. § 806.05(f) sets forth the required showing of distinctness by the examiner and the acceptable rebuttal by the applicant to overcome this showing.

Petitioner appears to assert that the Examiner's example of a materially different process, a screening process, is not a materially different process from the process recited in the group of claims including claims 31-47.

This assertion is not convincing since the Petitioner has not claimed that the electronic chip device is manufactured just using a screening process. Petitioner claims that the chip device is manufactured using the steps of providing an interface support film and affixing at least one microcircuit on the interface support film and connecting the microcircuit to the interface. Petitioner's process to achieve advantages of the claimed invention necessitates the additional method steps claimed. Although the electronic chip device can be made using just a screening process, petitioner's method claims has additional step not necessarily required in the device claims. An example of an additional step is the affixing of the compensation film carried out *before* the microcircuit is fixed to the support film.

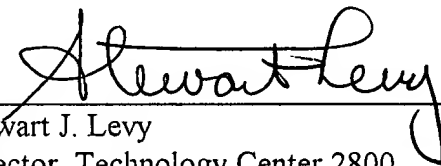
The record reveals that the examiner properly followed the Office guidelines as set forth in M.P.E.P. § 806.05(f) quoted above. The examiner has satisfied the burden of showing distinctness between the two groups of claims. In return, petitioner shall either prove or provide a convincing argument that the alternative use suggested by the examiner cannot be accomplished. Petitioner has not proved nor provided a convincing argument in the traversal to the restriction requirement submitted July 5, 2001, or in this petition.

The record reveals that the examiner properly follows Office practice and procedures and the restriction requirement has not been shown to be in error. Reversal of the examiner's position is not warranted.

For the above stated reasons, the petition is DENIED.

Any request for reconsideration of this decision must be filed within two months of the date of this decision in order to be considered timely.

The application file is being returned to the Technology Center 2800 Central Files where it awaits a response to the non-final Office action of July 5, 2001


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